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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/035,966	11/09/2001	Stephen V. Burakoff	N00389/70006 RJP	3768
7590 03/04/2009				
Randy J. Pritzker Wolf, Greenfield & Sacks 600 Atlantic Avenue Boston, MA 02210			EXAMINER CHANDLER, SARA M	
			ART UNIT 3693	PAPER NUMBER
			MAIL DATE 03/04/2009	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/035,966

Applicant(s)

BURAKOFF ET AL.

Examiner

SARA CHANDLER

Art Unit

3693

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12/11/08.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 114 - 125; 196 - 212; and 220 - 251 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 114 - 125; 196 - 212; and 220 - 251 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

This Office Action is responsive to Applicant's arguments and request for reconsideration of application 10/035,966 (11/09/01) filed on 12/11/08.

Election/Restrictions

Claims 114, 212, 221 and 249 are generic to the following disclosed patentably distinct groups of species:

- A. Claims 119, 120, 121, 226, 227 and 228, drawn to enabling the delivery of information. Election to one of the following species is required.
1. Claims 119 and 226, wherein enabling delivery of information comprises sending the information to the user in electronic form.
 2. Claims 120 and 227, wherein enabling the delivery of information comprises providing instructions for obtaining the information electronically.
 3. Claims 121 and 228, wherein enabling delivery of information comprises providing an address on the internet where the information is located.
- B. Claims 122, 199, 200, 207, 230, 236, 237, 244, drawn to the consent is deemed given by. Election to one of the following species is required.
1. Claims 122 and 230, wherein consent is deemed given by an affirmative action from the user.
 2. Claims 199 and 236, wherein consent is deemed given by the user upon the user expressly consenting to electronic delivery.

3. Claims 200 and 237, wherein consent is deemed given by the user when a predetermined period passes after requesting the user's consent without the user having expressly consented to electronic delivery.
 4. Claims 207 and 244, wherein consent is deemed given by the user if consent is deemed given by an entity acting on behalf of the user.
- C. Claims 202, 203, 239, 240, drawn to the first type of information relates. Election to one of the following species is required.
1. Claims 202 and 239, wherein the first type of information relates to a first type of document.
 2. Claims 203 and 240, wherein the first type of information relates to a first type of transaction.
- D. Claims 201, 204, 205, 220, 231, 238, 241, 242, 248, 251, drawn to requesting consent.
1. Claims 201 and 238, wherein requesting consent comprises requesting the user's consent to the electronic delivery of a first type of information, and wherein enabling the delivery of the information comprises enabling the delivery of information of the first type to the user.
 2. Claims 204 and 241, wherein requesting consent comprises requesting the user's consent to a single delivery of information.
 3. Claims 205 and 242, wherein requesting consent comprises requesting the user's consent to one or more electronic deliveries of information to occur in the future.

4. Claims 220, 248 and 251, wherein requesting consent comprises expressly requesting the user's affirmative consent.
 5. Claim 221, wherein requesting consent comprises sending a computer-readable device to the user.
- E. Claims 209, 210, 246 and 247, drawn to making the one or more other items of information available to the user.
1. Claims 209 and 246, wherein making the one or more other items of information available to the user comprises making the one or more other items available to the user in hard copy form.
 2. Claims 210 and 247, wherein making the one or more other items of information available to the user comprises making the one or more other items available to the user in electronic form.

The species are independent or distinct because as disclosed the different species have mutually exclusive characteristics for each identified species. In addition, these species are not obvious variants of each other based on the current record.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable.

There is an examination and search burden for these patentably distinct species due to their mutually exclusive characteristics. The species require a different field of search (e.g., searching different classes/subclasses or electronic resources, or employing different search queries); and/or the prior art applicable to one species would

not likely be applicable to another species; and/or the species are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species to be examined even though the requirement may be traversed (37 CFR 1.143) **and (ii) identification of the claims encompassing the elected species**, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

The election of the species may be made with or without traverse. To preserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the election of species requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR 1.144. If claims are added after the election, applicant must indicate which of these claims are readable on the elected species.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the species unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other species.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141.

The examiner has not contacted the applicant for election over telephone due to the complex nature of the election/restriction requirement (see MPEP §812.01 (R-3)).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SARA CHANDLER whose telephone number is (571)272-1186. The examiner can normally be reached on 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Kramer can be reached on 571-272-6783. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

SMC

/JAGDISH N PATEL/
Primary Examiner, Art Unit 3693